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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,575	08/06/2002	Sydney Gordon Low	DAVI147.001APC	1720
20995	7590	05/19/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			CORRIELUS, JEAN M	
2040 MAIN STREET			ART UNIT	PAPER NUMBER
FOURTEENTH FLOOR				
IRVINE, CA 92614			2162	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/009,575	LOW ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jean M. Corrielus	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19-36 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-36 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This office action is in response to the Appeal Brief filed on March 3, 2006, in which claims 19-36.

### ***Response to Arguments***

2. Applicant's arguments filed March 3, 2006 with respect to claims 19-36 have been fully considered and are persuasive. The final rejection of the last office action has been withdrawn in view of a new ground of rejection. The office is sorry for the inconvenient that is caused the Appellant in reopening the prosecution.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 19-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the claimed feature of "providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing" is not described in the specification to enable one having ordinary skill in the art to make and use the invention. Applicant stated that the specification page 4, line 29-page 5, line 8 provides support for the abovementioned limitations. However, the cited portion as cited by Applicant states "*the e-mail manager determines whether the recipient*

*has chosen an option on the web page to read the highlighted message, and if not, operation proceeds. Otherwise, the message is displayed for the recipient's browser, and operation proceeds. So, the e-mail manager determines whether the recipient has selected an option on the web page to save the highlighted or read message, and if so, operation proceeds to save the message. A forward procedure is called to execute the message and proceed to save the message and then return to a loop. Furthermore, the email manager determines whether the recipient has selected an option to delete the highlighted or read message". Such passage as cited by the appellant has nothing to do with providing the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing.*

The examiner finds that the cited portion of the Appellant disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application. Based on the analysis provided above and substantial evidence or reasoning, the examiner provided that one having ordinary skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. The amended claims, which introduce elements or limitations “, without using a self-removing message indicator, after viewing“ are not supported by the as-filed disclosure, which is violated the written description requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Appellant should duly note that the first paragraph of 35 U.S.C. 112 requires that the “specification shall contain a written description of the invention. Appellant should also note that the essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed; and to put the

public in possession of what the applicant claims as the invention.” Furthermore, the written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent’s term. Indeed, the specification does not satisfy the written description requirement because the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier US Patent no. 6,480,885 and Ogilvie et al., (US Patent no. 6,324,596).

As to claims 19 and 36, Olivier discloses an analogous system that enables users to exchange group electronic mail by establishing individual profiles and criteria for determining personalized subsets within a group (col.17, lines 7-12). In particular, Olivier discloses the claimed “determining if a message is approved for a recipient of the message” determining whether the message meets the acceptance criteria data by determining the sender’s email address and checking the database to be sure the message is from a subscriber of the specified list, if the message does meet the sender’s message profile acceptance criteria data, meaning if

she is not a subscriber, the message is rejected and a rejection return email is sent to the sender (col.13, lines 15-19, lines 62-67; col.15, lines 5-10); “processing the message for subsequent viewing by the recipient if the message is approved” So, if the message meets the acceptance criteria, meaning the message is approved, then the message is distributed to all the recipients in the sender’s recipient list for viewing, the approval user is emailed with a request for approval and display the email message from the subscribers who match the user’s message acceptance criteria data (fig.10(1) and fig.10(2); col.13, line 66-col.14, line 5; col.15, lines 11-15; col.17, lines 7-20; col.18, lines 39-50); “notifying the recipient and storing the message, if the message is unapproved” if the message is rejected, the sender is informed via email of the rejection return email (col.13, lines 18-21, lines 55-67; col.15, lines 13-15) and if the message is not approved after n days it is removed from a suspended messages table in the database and returned to the sender (col.15, lines 5-14) but if the message is older than n days transfer the message to a secondary database server or move the message bodies to the secondary database (col.18, lines 60-64); and “selectively delete the message” as a juncture to reduce the subset by removing recipients whose message criteria is not met by the sender’s message (col.13, lines 15-28). However, Olivier does not explicitly disclose “provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing”.

Ogilvie, on the other hand, discloses an analogous system for providing email message originator and distributors with default control over message removal at a message recipient’s location regardless of whether the message has been opened. In particular, Ogilvie provides email recipients with the capability to manage unsolicited email messages without the messages

inadvertently removed by a message filter (col.1, lines 55-64; col.14, lines 26-39). Appellant should duly note that Ogilvie' system has the capability, both, of not requiring that recipients affirmatively remove unwanted email or create a reply message having remove in the subject to indicate their lack of interest in the subject matter (col.11, lines 1-6) and determining whether they contain any self removing message indicators from message originators then automatically notifying the recipient according to the instruction of the replacement message (col.13, lines 1-5; col.14, lines 28-39). Ogilvie discloses the claimed features "provide the recipient with an option to view the unapproved message and selectively delete the message, without using a self-removing message indicator, after viewing" by allowing recipient to overwrite the self-removing message after the unapproved being read, wherein the recipient has provided the option to manually delete the unapproved message by moving it from the inbox to the trash folder after the message has been read (col.9, lines 59-66). Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references, wherein the message distribution provided therein (See Olivier's fig.10 (2)) would incorporate the use of selectively deleting the message, without using a self-removing message indicator, after viewing, in the same conventional manner as disclosed by Ogilvie (col.9, lines 59-66). One having ordinary skill in the art would have been motivated to utilize such a combination for the purpose of enhancing the security of the system by reducing the number of message copies and the life span of those copies.

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Claim 20, Olivier and Ogilvie discloses substantially the invention as claimed. In addition Ogilvie discloses the claimed “allowing the recipient to view an unapproved message” as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39).

As to claim 21, Olivier and Ogilvie disclose substantially the invention as claimed. In addition, Ogilvie discloses the claimed “notifying the recipient with a notification message having a link to network data representing a list of unapproved messages for the recipient” as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.13, lines 1-5; col.14, lines 28-39; col.9, lines 59-66).

As to claim 22, Since Olivier discloses a web browser plug-ins and other new technology that allow the exchanged messages to be stored somewhere other than the currently viewed web site, retrieve messages from the independent data store and displayed to the user and use an address of a specific page being viewed within the web site (col.25, lines 25-41), the claimed wherein the network data comprises markup language data accessible by a computer device of the recipient is met.

As to claim 23, Olivier discloses the claimed allowing the recipient to set criteria to determine if the message is approved (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 24, Olivier discloses the claimed wherein the criteria include a sender of the message being on a stored approved list for the recipient (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 25, Olivier discloses the claimed allowing the recipient to change the criteria (col.17, line 65-col.18, line 4).

As to claims 26-27, Olivier discloses the claimed notifying a sender of the unapproved message of deletion of the unapproved message (col.14, lines 56-58; col.15, lines 4-14).

As to claim 28, Olivier discloses the claimed wherein the message and the criteria are stored on an electronic message server (col.5, lines 5-45).

Claim 29 is system for performing the method of claim 19 above. It is, therefore, rejected under the same rationale.

Claim 30 is system claim for performing the method of claim 19 above, which is substantially disclosed by Olivier and Ogilvie. In addition, Ogilvie discloses the claimed “an electronic message server for receiving and storing electronic messages for a recipient” email server 345 (col.8, lines 55-65) and “an electronic message manager for processing electronic messages for a recipient” (col.9, lines 30-40)

Claims 31-32 are computer system performing by the method of claims 19-28 above. They are, therefore, under the same rationale. In addition, Ogilvie discloses the use of storing and sending a notification to the recipient of unapproved message (col.1, lines 46-53); an access server for generating a display page with a list of unapproved message (col.5, lines 6-45); wherein the list of unapproved messages includes links to the unapproved message respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient" (col.1, lines 55-65; col.14, line 26-38).

As to claim 33, Olivier discloses the claimed wherein the criteria include the sender of a message being on an approved list for the recipient stored on the system (col.14, line 55-col.15, line 15).

As to claims 34-35, Olivier discloses the claimed wherein the display page includes a link to at least one display page for displaying and changing the criteria ((col.17, line 65-col.18, and line 4).

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M Corrielus  
Primary Examiner  
Art Unit 2162

May 15, 2006